

Appl. No. 10/785,999
Amdt. Dated March 25, 2008
Reply to Office Action of January 17, 2008

REMARKS

Claims 1-3, 6-7, 10-15, 18-19, and 22-26 remain in the application.
Claims 1 and 13 are independent.

Independent claims 1 and 13 have been amended to clarify that when said keyboard is attached to the device, said keyboard overlies a touch-sensitive element and said display screen (see first sentence, [0063] of the Applicant's description), and that the touch-sensitive element overlies the display screen (see first sentence, [0046]). Claims 6, 7, 11, 18, 19, 23 and 24 have been amended to recite that the keyboard is adapted to be attached to the device, to be consistent with the wording used in the description (see e.g. [0046], [0050], [0063], [0068], [0069]). Claims 11 and 23 have been amended to clarify that the keyboard is adapted to be attached to the device by a user (see first sentence, [0058]). No new matter has been added.

Claims 1-3, 6, 7, 11, 13-15, 18-19, 22, 23 and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lennart (EP 1292086) in view of Dreher (US 4,551,717). Claims 12 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lennart in view of Dreher, and further in view of Taylor et al (US 7,151,528). Claims 10 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lennart in view of Dreher, and further in view of Bradenburg et al (US 5,499,041). The Applicant respectfully traverses all rejections.

Insofar as the claims that remain in the application are rejected in view of the teachings in Lennart and Dreher, it is respectfully submitted that it is not possible to combine the teachings of these prior art documents to obtain the Applicant's claimed combinations.

First, there is no suggestion in Dreher that the spring 22, which the Examiner indicates corresponds to the at least one actuator as claimed, can be applied to keyboards that overlie a touch-sensitive element, the touch-sensitive element overlying a display screen of a device (e.g. a mobile device). The claims require that the actuator be disposed in the housing of the keyboard, and that when the keyboard is attached to the device, the keyboard overlies a touch-sensitive element and the display screen. At col. 2 lines 32-34, and as further illustrated in Fig. 2 of Dreher, the device 15 has a multi character display 40. However, if Dreher's "device 15" corresponds to the Applicant's claimed device that provides a display screen, it would be clear that the spring 22 is not in a "housing" of a keyboard that overlies the display screen. In fact, it appears that spring 22 underlies the display screen. This may have the effect of increasing the overall thickness of the construction as compared to the Applicant's claimed embodiments. Accordingly, Dreher teaches away from the subject matter of the Applicant's claims.

Second, Dreher teaches a spring 22 coiled around the central shaft 21 (see col. 2, lines 49-50). If the spring 22 is to be disposed in a housing of a keyboard adapted to overlie a touch-sensitive element (which in turn is to overlie the display screen), the display 40 would need to be repositioned below the spring/shaft structure. However, this spring/shaft structure would obstruct the view of the underlying display 40. Accordingly, the combination of the teachings of Dreher and Lennart teach away from the subject matter of the Applicant's claims.

Third, claims 11 and 23 are directed to embodiments where the keyboard may be attached to and detached from the mobile device (i.e. the keyboard is removable). As noted in the preamble of the claims, the Applicant's keyboard is for use with devices that provide a display screen. The ordinary skilled person would not reasonably conclude that Dreher could be combined with Lennart to

arrive at the Applicant's claimed removable keyboard. If the keyboard in Lennart were to be modified to incorporate the actuators in Dreher, the keyboard would no longer be one that is removable from a device that provides a display screen, as explained below.

In the paragraph at col. 2 lines 58-65, Dreher teaches that a flexible cable 23 connects the device and key cap to interconnect pins 17, and that the "mounting tabs 16 provide a means to secure the key body to a key board base or keyboard circuit to hold it in place with respect to the other keys on the keyboard". From this paragraph, it is clear that the spring 22 and the display 40 are provided in an integrated construction of a given key for a keyboard. If the key structure (i.e. device 15) of Dreher were to be detached at the mounting tabs 16, the display 40 would also be removed. The ordinary skilled person would understand that a keyboard constructed from multiple Dreher keys would not be designed for use with an underlying device providing a display screen. Each key in Dreher already provides its own display. There would be no need to allow images on an underlying display screen (e.g. of an existing device, see [0071] of the Applicant's description) to be viewed through the keys. Accordingly, the ordinary skilled person would not be led to adopt this type of keys with the keyboard of Lennart. For these additional reasons, the disclosure in Dreher teaches away from the subject matter of the Applicant's claims.

The claims recite a keyboard for use with a device in which a display screen for displaying output to a user is provided, said keyboard comprising: a housing for supporting said keys, wherein said keyboard is adapted to attach to said device such that said keys overlie at least a part of said display screen, wherein said housing further comprises at least one actuator disposed therein for each of said plurality of keys. As noted above, at least some of these features are neither taught nor suggested in the documents cited by the Examiner. In the event that the cited references fail to disclose or suggest all of the elements

Appl. No. 10/785,999
Amdt. Dated March 25, 2008
Reply to Office Action of January 17, 2008

recited in the claims, then combining elements from the references would not yield the claimed subject matter, regardless of the extent of any teaching, suggestion or motivation.

Although the Supreme Court in the case of KSR Int'l Co. v. Teleflex Inc., No. 04-1350 (April 30, 2007) did not reject use of a "teaching, suggestion or motivation" analysis, the Supreme Court did say that it was not the only possible analysis of an obviousness question. The Examiner is requested to confirm that the Examiner's chosen ground for rejection is a "teaching, suggestion or motivation" analysis. In the event that the Examiner chooses to consider a different avenue for rejection, this would be a new ground for rejection not due to any action by Applicant. Applicant has a right to be heard on any new ground for rejection.

For the foregoing reasons, it is respectfully submitted that the subject matter of claims 1 and 13, and the claims dependent thereon, are inventive over at least the combination of Lennart and Dreher documents as cited by the Examiner, and withdrawal of the rejections under 35 U.S.C. 103 is respectfully requested.

The Applicant respectfully submits that the application is now in form for allowance, and a Notice to that effect is earnestly solicited.

Respectfully submitted,
Bereskin & Parr
Agents for the Applicant

By 
Kendrick Lo, Reg. No. 54,948
(416) 364-7311